

#10
DW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application Serial No. 10/060,142

Filed: February 1, 2002

Examiner: Basinger, S. D.

For: ERGONOMIC SWIM FIN APPARATUS

Art Unit: 3617

RENEWED PETITION UNDER 37 CFR 1.181

Request for Reconsideration of Commission's Decision

RE: Petition to Withdraw Holding of Abandonment

To: Commissioner for Patents
P.O. Box 1450
Technology Center 3600
Alexandria, VA 22313-1450

RECEIVED

MAR - 1 2004

GROUP 3600

Dear Sir:

Through this communication, Petitioner requests reconsideration of the Commissioner's decision dated January 30, 2004 dismissing Petitioner's initial request seeking withdrawal of the holding of abandonment in the above identified patent application.

INTRODUCTION

Petitioner's initial request, dated September 26, 2003, sought that the holding of abandonment be withdrawn. In his request, Petitioner explained his failure to respond to the Office Action of February 14, 2003 as due to his non-receipt of said Action. In the Dismissal Decision relative to that initial petition, the position of the Commissioner is that Petitioner's *showing* relative to the alleged non-receipt of the Action is insufficient to overcome the strong presumption that mail properly addressed and delivered to the United States Postal Service (USPS) was in fact delivered to the addressees.

Petitioner states herein to the best of his knowledge and without reservation that the subject Office Action never arrived at its intended destination at 2725 Vista Court in Waldorf, Maryland where he has lived with his wife for many years. In support of Petitioner's statement, Petitioner's spouse, Carolyn Melius, also presents a verified statement herein. In her statement, Mrs. Melius relates her own activities and observations relative to the subject Office Action and its non-receipt.

The explanation below, coupled with the attached assemblage of statements, photographs and other related evidence, demonstrates Petitioner's best efforts to offer detailed and convincing information and evidence that will support the Commissioner's grant of this renewed petition. It should be noted that this Renewed Petition has been prepared with the valuable guidance which Special Programs Examiner Randy Reese graciously incorporated into the initial Dismissal Decision. This Renewed Petition is offered respectfully as Petitioner's earnest request for reconsideration of the Dismissal Decision and that the holding of abandonment be withdrawn.

ABOUT THE PETITIONER

For the last few years, Petitioner tenaciously pursued the serious and full time vocation of new product development, including intellectual property protection procurement, prototyping and pursuit of license agreements. The subject patent application is one of Petitioner's pending patent applications prosecuted *pro se* before the USPTO. Petitioner performs his patent prosecution work out of his home office at 2725 Vista Court, Waldorf, MD, where he also

operates a product development and licensing business, recently co-founding Morfin Corp. (a Maryland corporation) with Mrs. Melius to commercialize the patents issued to him.

HOW OFFICIAL CORRESPONDENCE IS HANDLED

Waldorf, Maryland by Washington, DC standards, is a relatively rural community not far from the USPTO. To ensure safe and timely delivery of correspondence to the USPTO, Petitioner always makes the thirty-mile auto trip to personally deposit his papers at the Office at its Arlington, VA campus. On the other hand, Petitioner must rely upon the United States Postal Service (USPS) for delivery of all Official correspondence directed to his Waldorf location.

Postal mail delivery typically arrives at 2725 Vista Court in a USPS vehicle almost every weekday. Among the mail received at this address are bills, promotional letters and ads, personal correspondence, parcels, meeting notices, magazines, and all correspondence relative to Petitioner's product development business/corporation, the most important of which is incoming USPTO correspondence. The delivered mail always is placed by the post-person directly within Petitioner's mailbox. Petitioner's mailbox is a typical, rural-type box, equipped with hinged metal flag and swing-down door. This mailbox, designated "2725" is affixed to the top of a free-standing post planted at the edge of the roadway at the end of Petitioner's driveway. [Exhibit 1]

Petitioner's spouse, with only rare exception, retrieves received mail from the mailbox and carries it the short distance into the family residence/office. Upon entering the residence, Petitioner's spouse sorts the mail, and immediately passes to Petitioner any correspondence relative to the product development business/corporation and/or patent applications. Over many years, this has been, and continues to be, Petitioner's family routine - - a routine interrupted or altered only rarely when Petitioner and/or his spouse are on extended travel away from their residence/office, or when postal mail delivery service is disrupted by a holiday or unusually inclement weather.

PRESENCE AT THE RESIDENCE

Petitioner asserts in his verified statement that he was present at the residence every day from prior to the February 14, 2003 mailing date of the subject Office Action, until at least March 7, 2003. This 22-day period surely would cover any reasonable period of mail delivery from the USPTO in Crystal City Arlington, VA to Waldorf, MD. Considering their consistent routine and the very limited handling required for mail arriving at 2725 Vista Court, Petitioner and Petitioner's spouse confidently assert that they did not receive the subject Office Action during the noted period nor, in fact, at any other time.

Petitioner and his spouse do, however, recall occasions in the past year when it was necessary to report to the local USPS authorities that mail had been stolen from their rural box. More significant is another period of "disrupted" mail delivery service due to a severe snow storm. The timing of this "disabling" storm relative to the reported mailing date of the subject Office Action, is highly significant. The resultant disruption of USPS and other government services described most certainly would have impacted any attempt at delivery of the subject Office Action.

PRESIDENT'S DAY BLIZZARD

On the workday immediately following the stamped mail date of the Office Action in question, the entire Washington region suffered a disabling snowstorm. Washington, DC Mayor Anthony Williams was quoted as saying it would take sixty hours to dig out; President Bush shut down the Federal Government for two days. Explaining the shut-down, a spokesperson for the US Office of Personnel Management said, "The decision...would help reduce commuting problems on local roads, many of them still unplowed and impassable after nearly two feet of snow." [New York Times, Feb. 17, 2003, Exhibit 7] Accordingly, the USPTO itself was closed (Under Secretary James Rogan, *USPTO Official Gazette Notice* dated Feb. 24, 2003, Exhibit 8). And, at the time, a report by the Association for Postal Commerce noted that it was not until February 19th that the US Postal Service was "getting back to its usual schedule," and that "roads remain impassible and mailboxes are buried beneath mounds of snow." Carriers were told "not to compromise their safety and health." [Postal News, February 2003, Exhibit 9]

In his accompanying verified statement, Petitioner references this blizzard condition, noting its considerable impact on mail delivery service at 2725 Vista Court in Waldorf, MD. Petitioner asserts that, for days, no mail whatsoever was delivered to the mailbox. When mail delivery resumed, it appeared to Petitioner that backed-up deliveries eventually found their way to the Vista Court mailbox, yet Petitioner firmly asserts that such delivery did not include the subject Office Action - - coincidentally noted as dated February 14, 2003 just as that horrendous, wintry blizzard was closing on Washington.

Had the Office Action arrived, even many days or weeks later, it most certainly would have found warm hands welcoming it into the Petitioner's house, and into Petitioner's filing system.

PETITIONER'S FILING SYSTEM

Either immediately or very shortly after receiving product development business/corporation-related mail and/or patent application related mail, Petitioner always reviews the correspondence, and determines if and when a response is required. Such correspondence is then stored for future reference within a carefully organized filing system now to be described. Petitioner states that this particular piece of mail was eagerly anticipated, and he asserts that he would well-remember its receipt. Petitioner's spouse also was keenly aware of her husband's anticipation of the long-awaited Office Action. Both confidently assert in verified statements that they have no recollection of ever receiving or handling the subject Office Action dated February 14, 2003, nor of placing said Action into Petitioner's filing system. Inspection of this filing system, as represented in the attached photographs referred to below and in accompanying verified statements as **Exhibits 1-6**, will evidence the impressive thoroughness of its organization.

For a number of years, Petitioner has maintained a filing system which includes two vertical, multi-drawer filing cabinets [**Exhibit 3**], as well as a second pair of containers in the form of suspension-folder (or hanging-folder) boxes [**Exhibit 4**]. Within one of the suspension-folder boxes is a set of suspension-folders or hanging-folders maintained for product development business/corporation papers. Within the other of the two suspension-folder boxes is another assembly of suspension-folders carefully arranged to receive and retain Petitioner's patent-related material, documents and correspondence (henceforth referred to as "papers"). [**Exhibit 2**]

The folder just described, is where all USPTO-related communications and related documents, such as Office Actions, postcard receipts, notices, responses, draft responses, search reports and so forth (henceforth referred to as "papers") relative to the subject patent application are kept. Except for those occasions when Petitioner is actively engaged in reviewing one or more such "papers" at his home-office desk, such papers and files reside only within their assigned folder.

Throughout the time period when the subject Office Action could reasonably be expected to have been delivered, these files were arranged as described herein, and Petitioner was the only person ever to access the suspension-folders reserved for such "papers." Thus, during said time period, Petitioner was well aware of the arrangement and content of the suspension-folders under his supervision and control.

Each of Petitioner's current patent applications is specifically allocated one suspension-folder within the patent-related assembly of suspension-folders. Each folder is appropriately labeled with its associated invention title (i.e., corresponding to the title presented in the pending patent application). As would be expected, one such folder is designate ERGONOMIC SWIM FIN the title of the subject application. Normally retained within the suspension-folder box identified in the accompanying photograph, [**Exhibit 5**], this folder may be withdrawn for access to its contained files. [**Exhibit 6**]

Each folder (within the patent-related suspension-folder), from rear toward front, represents a chronological history of events in patent prosecution. For example, close inspection of the files

shown in Exhibit 6, shows that the Examiner's First Office Action occupies the fourth most-recent "event," and is directly followed by a more recent file designated as a draft response to the first Office Action. Subsequent to the draft response file is still a more recent file designated as the "clean copy revised," and would be a duplicate of the final version Petitioner carried to the USPTO.

Intuitively, the file which followed Petitioner's response to the First Office Action should be designated as Examiner's Final Office Action. Instead the next (or latest) file is designated: "Notice of Abandonment," and the papers shown in Exhibit 6 as partially removed therefrom relate to Petitioner's earnest attempts to persuade the Commissioner for Patents to withdraw the holding of abandonment. Had the subject Office Action of February 14, 2003 been received at 2725 Vista Court, it would occupy a newly created file instead of an Abandonment Notice, and would already be followed by an even newer file carrying Petitioner's response to the Final Office Action. Petitioner asserts that his filing system indicates that the February 14, 2003 Office Action was never received. Assuming for sake of argument that the Office Action was received but misfiled within the suspension-folder box or one of the other file containers, Petitioner asserts that a thorough search would have discovered the missing papers.

SEARCH OF THE FILES

Following receipt of the Notice of Abandonment, Petitioner and Petitioner's spouse assert that they set upon a thorough search of their entire filing systems, as above described, focusing primarily upon the patents-related suspension-folder box and the "papers" therein. In fact, in an all-out attempt to locate the subject Office Action, all current files in the household have been searched including the two vertical file cabinets used only for personal and business activities.

As they relate in their respective, verified statements, Petitioner and Petitioner's spouse performed this thorough search on more than one occasion. Their considered conclusion is that the subject Office Action dated February 14, 2003 was not present in those files. [NOTE: Subsequent to the holding of abandonment, Petitioner has received and appropriately filed a faxed photocopy of the original, generously furnished by Art Unit 3617 Supervisory Patent Examiner Morano]

Further, Petitioner and Petitioner's spouse jointly searched other storage areas or locations within their residence where USPTO correspondence could reasonably have been misplaced with unrelated mail such as bills or personal correspondence. The additional search efforts were fruitless, leading them to their position that the Office Action dated February 14, 2003, if it had been received, was never stored or filed within the residence.

FOLDERS AS VISUAL REMINDERS

Petitioner's pending patent application portfolio rarely exceeds two simultaneously pending applications. Thus, when an Office Action is received from the USPTO, any *due date* for response effectively established, for example, by Examiner invoking a shortened statutory period (or SSP) for response is immediately and mentally noted by Petitioner, as he places the paper within a newly labeled file, and stores the new file within its associated folder.

For ease of future reference and/or confirmation of response deadlines, a received Office Action is placed within its file at the front of its specially designated folder. In the ongoing pursuit of his chosen vocation, Petitioner determines his *window for response* from the response period set in the Action, and immediately plans a specific time period within which to develop the required response, affording an adequate margin to avoid late fee charges whenever possible. Over the course of the response period, Petitioner will repeatedly access and review the Office Action, and will perhaps spend more than a month in formulating and finalizing his response. Each act of accessing a filed Office Action, whereon is printed the time period for response, serves as an ever-present, prompting reminder of Petitioner's response deadline.

Also, an important benefit of Petitioner's filing system is the instant visual status indication presented by the chronological arrangement of files within each folder.

EARLY CONCERN FOR NON-RECEIPT OF OFFICE ACTION

Once Petitioner has submitted a new patent application or response to an Office Action, he typically anticipates the date by which USPTO's response would reasonably be expected. For example, after filing a response to a First Office Action, Petitioner would retain a copy within a labeled file at the front of its associated suspension-folder. At that time, Petitioner would make a mental note that the Examiner's response or decision may be received within two-three months. Thus, the presence of a dated copy of Petitioner's latest outgoing communication to the USPTO serves as a constant visual reminder that the Examiner's decision has not been received. The dated copy of Petitioner's latest outgoing communication is periodically reviewed to confirm the date of submission and expected date for receipt of further communication from the USPTO.

In December, 2002 Petitioner filed a response to the Examiner's First Office Action (the Action preceding the Final Office Action of February 14, 2003). Having spent a great deal of time formulating his substantial reply, Petitioner eagerly monitored incoming mail at 2725 Vista Court where he anxiously awaited the Examiner's reaction. Petitioner states herein that, while his own mental recollection and file folder information signaled that the Examiner's response should be arriving, Petitioner grew very concerned around the third month. However, he notes that his concern was ameliorated by constant news of USPTO's growing backlogs. Besides, he states that he thought it best not to pester the Examiner with inquiries.

RECENT MODIFICATION IN RECORD-KEEPING, DOCKET-MONITORING

From Petitioner's recent experience and ongoing discussions with a number of other independent inventors and product developers, he believes that his established methods of file maintenance, record-keeping and correspondence-tracking have been typical for most non-professional practitioners. Unlike active patent attorneys and patent agents, Petitioner has not dealt with a large caseload and high docket activity, and has experienced very little, if any, overlapping response dates.

With only one or two patent applications typically pending, Petitioner has reliably *made* a mental note that an Office Action has been received or may be due, and subsequently has successfully relied both upon memory and regular periodic file access for prompting reminders. Nonetheless, Petitioner acknowledges possible shortcomings of his docket maintenance methods (leading to his Renewed Petition under 37 CFR 1.181). Accordingly, Petitioner has established a new docket record-keeping "tickler" along with a calendar-based reminder system to significantly upgrade his recordkeeping facilities and capabilities.

Petitioner has now leased a post office box at his nearest US Post Office, and further will immediately secure a USPTO Customer Number so as to monitor Office activity relative to his pending patent applications. While a Registered Patent Agent has been engaged to assist with upgrading his mail handling arrangements and to present this Renewed Petition, Petitioner will continue to receive and handle Official correspondence. Hopefully, the present Petition will receive favorable consideration, in which case this Patent Agent's *power* will be revoked as Petitioner resumes *pro se* prosecution, facilitated by his newly designed record-keeping system.

STATEMENTS AND EVIDENCE ATTACHED

As referred to above, Petitioner's verified Statement and the verified Statement of Petitioner's spouse accompany this Renewed Petition as part thereof. Also accompanying this Petition and forming a part thereof are photographs and other related exhibits designated **Exhibits 1-9**. Enclosed herewith is a Power of Attorney executed by Petitioner appointing the undersigned

practitioner, along with a change of address for Petitioner's receipt of correspondence from this time forward. It is respectfully requested that each of these additional documents be accepted for review and consideration.

CONCLUSION


In 1993, the USPTO issued a Notice of revised policy relative to required showings of non-receipt of an Office Action (1156 Official Gazette 53). The purpose of the notice was to "minimize costs and burdens to the Practitioner and the Office" in presenting a *showing* that would overcome the strong presumption that stood for twenty years following *Delgar v. Schuyler*, 172 USPTQ 513 (D.D.C. 1971). Following the 1993 Notice, the *showing* was limited to: (1) a "statement" of from the practitioner asserting that the Office Action was not received and that a search of the file jacket and docket records indicates that the Office Action was not received; (2) provision of a copy of the docket record (appropriately referenced in the practitioner's statement) where the Office Action, if received, would have been entered.

Petitioner respectfully urges that his organized filing system of suspension-folders, and the role they play in managing Petitioner's limited portfolio, be considered under the circumstances described as also sufficient to show that the Office Action of February 14, 2003 was not received. Petitioner and his spouse have made the required "statements" and therein refer to the folder which would have contained the Office Action - - had it been received.

For whatever reason, extraordinarily inclement weather conditions or still other reasons beyond Petitioner's range of knowledge and control, the subject Office Action was never received.

In light of the circumstances described and the submission of all exhibits and statements reasonably required, Petitioner requests favorable consideration of this Renewed Petition resulting in the withdrawal of the holding of abandonment and the re-mailing of the Office Action originally dated February 14, 2003.

Respectfully submitted,



Donald Grant Kelly
Registration No. 30521

Office of Donald Grant Kelly

Intellectual Asset Management Associates, LLC
515 King Street, Suite 420
Alexandria, VA 22314
Ph: 703 548 8213
Fx: 703 684 6048